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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/856,345	05/18/2001	Hilmar Franke	FA-1010	6864
7590	09/29/2004		EXAMINER	
E I du Pont de Nemours & Company Legal Patents Wilmington, DE 19898			FULLER, ERIC B	
			ART UNIT	PAPER NUMBER
			1762	

DATE MAILED: 09/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/856,345

Applicant(s)

FRANKE ET AL.

Examiner

Eric B Fuller

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-16, 18 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-16, 18 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 12, 2004 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11-16, 18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shvartsman (EP 0 439 050 A2) in view of Yin et al. (US 4,978,593) in further view of Lewis et al. (US 4,519,065).

Shvartsman discloses a process for making a hologram by applying a radically curable coating agent to the surface of a transparent substrate, embossing the coated surface by pressing it with an embossing die and then passing actinic radiation through the transparent substrate so as to cure the film while it is in contact with the embossing

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die, and then separating the die from the photohardened film (abstract). It is explicitly taught that the die may be formed from an optically transparent material (page 7, lines 14-25). Shvartsman does not specifically teach the pattern of the die, however the pattern of the die impresses a desired pattern upon the surface of the substrate. The pattern formed on the substrate is a design choice, and is selected by the manufacturer to serve the appropriate purpose. Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to select a die press with a certain relief pattern that forms the specified pattern on the substrate. The reference teaches that the radiation is UV light (page 8, lines 45-52). This reads on the applicant's wavelength range. As the coating agent is curable by UV radiation, it is capable of being cured by thermal means. Shvartsman teaches a clear protective layer applied to the embossed layer (page 6, lines 34-45). As step E of the claims is only an optional step, as "if necessary" indicates, the teaching of the protective layer being applied to the embossed layer is sufficient to read on applying this layer before and/or after this optional step.

The reference fails to explicitly teach that the substrate is a motor vehicle part. However, Yin discloses applying holograms to the windshields of automobiles in order to provide playback coatings (abstract). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to apply the substrate, with the hologram, of Svartsman to a windshield. By doing so, one would reap the benefits of applying a playback coating to the automobile. As the substrate is applied to the vehicle, it now reads on being a vehicle "part thereof".

The combined references fail to explicitly teach that the radiation used for curing is passed through the transparent die. However, Lewis teaches that radiation for curing may occur through the transparent die such that films may be deposited on non-transparent substrates as well. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to radiate through the transparent substrate taught by Svartsmans. By doing so, the holograms may be applied to non-transparent substrates as well. The wider range of applicable substrates for the process taught by Svartsman is the motivation for combining these references.

Claims 11-16, 18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gili (US 5,318,807) in view of Yin et al. (US 4,978,593).

Gili discloses a process for making ultra-fine interference patterns by applying a radically curable coating agent to the surface of a substrate, embossing the coated surface by pressing it with a transparent embossing die and then passing UV radiation through the transparent die so as to cure the film while it is in contact with the embossing die, and then separating the die from the photohardened film (column 5, line 15 - column 6, line 8). Ultra-fine reads on the pattern spacing limitation.

The reference fails to explicitly teach that the substrate is a motor vehicle part. However, Yin discloses applying ultra-fine interference patterns to the windshields of automobiles in order to provide playback coatings (abstract). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to applying the substrate, with the interference pattern, of Gili to a windshield. By doing

so, one would reap the benefits of applying a playback coating to the automobile. As the substrate is applied to the vehicle, it now reads on being a vehicle "part thereof".

Response to Arguments

Applicant argues that Svartsman fails to teach coating the agent to a vehicle or a part thereof. This argument is not found convincing. Svartsman teaches to make a holographic coating on to a substrate. The process involves coating a curable layer to a substrate. Although the word "lamine" is used, in the context of the reference this is to differentiate between solvent-containing and solvent-free coatings. The layer is still a "film" and it is taught that it has a viscosity when being applied. This would be patentably indistinguishable with the term "coating". Yin teaches the obviousness of applying this substrate to a vehicle. Thus, the substrate reads on being a part for the vehicle.

Applicant argues the differences between an optical element and a hologram. This argument is not found convincing, as Svartsman teaches that the optical element is a hologram. Applicant also argues that the hologram of Svartsman would not be used for decoration. This is not found convincing as the combination of references suggests using the hologram for producing playback coating on vehicles, not a decoration.

Applicant argues that there is no motivation found in the art to apply the substrate of Svartsman to a vehicle. This is not found convincing. Yin teaches the desire to have holograms on vehicles. Svartsman teaches holograms on transparent substrates that would be ideal for applying to windshields. Thus, motivation is explicitly taught.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). The limitations of the claims and the motivation to combine are all found in the prior art cited.

In response to applicant's argument that the references are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, applicant argues that Svartsman and Lewis are far removed from vehicle parts. However, Svartsman and Lewis are both concerned with curing layers with radiation while the layers are being embossed with a die, which is reasonably pertinent to the particular problem with which the applicant is concerned. Furthermore, "or parts thereof" is a broad term that includes any part that may be on a vehicle, including a laminate for the windshield, thus the applicant's field of endeavor is inclusive of many substrates.

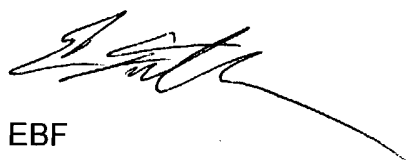
All other arguments are moot in view of the new grounds of rejection.

Conclusion

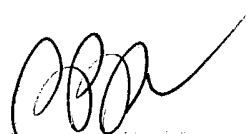
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric B Fuller whose telephone number is (571) 272-1420. The examiner can normally be reached on Mondays through Thursdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P Beck, can be reached on (571) 272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



EBF



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